

REMARKS

Claims 1 and 7 have been amended and claims 17-19 have been canceled. Therefore, claims 1, 3-8, 10-16, 21, and 22 are currently pending in the case. Further examination and reconsideration of the presently claimed application are respectfully requested.

Section 103 Rejections

Claims 1, 3-8 and 10-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,373,940 to Shaffer et al (hereinafter referred to as "Shaffer") in view of U.S. Patent Application No. 2002/0001301 to Sarkissian (hereinafter referred to as "Sarkissian"). Claims 21-22 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer. To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). None of the cited art teaches or suggests all limitations of the present claims, some distinctive limitations of which are set forth in more detail below.

Shaffer and Sarkissian fail, both separately and in combination, to provide teaching or suggestion for receiving an electronic notification of a change to a directory entry stored within an electronic communications device, wherein the electronic notification includes an identifier, category heading and an altered value. Amended claim 1 recites, in part:

An electronic communications device comprising: a processor; and a storage medium comprising program instructions executable by the processor for: receiving an electronic notification of a change to a directory entry stored within the electronic communications device, wherein the electronic notification includes an identifier, a category heading, and an altered value...

The presently claimed case provides a system and method for updating directory entries within an electronic communication device upon receipt of an electronic notification of a change to one or more directory entries. Electronic communication devices may include, but are not limited to telephones, facsimile machines and electronic organizers. The presently claimed system and method allows an existing directory entry (i.e., an entry stored within the directory of the electronic communications device) to be automatically updated upon receipt of an electronic notification of a change to a directory entry and an

acceptance command from a user of the device. As recited above, the electronic notification includes an identifier, a category heading, and an altered value. (See, e.g., Abstract and present claims).

On page 3 of the Office Action, the Examiner admits that Shaffer fails to provide teaching for receiving an electronic notification that includes an identifier, a category, and an altered value, and therefore, admits that Shaffer fails to teach or suggest all limitations of present claim 1. However, the Examiner suggests that "Sarkissian teaches such features (see col. 8, [0092-0094])", and further suggests that it would have been obvious to incorporate the "electronic notification" of Sarkissian into the teachings of Shaffer "in order to not frustrate [and] to copy down the error message correctly" (Office Action, page 3). The Applicant respectfully disagrees with the Examiner's assertion that teaching or suggestion for the presently claimed electronic notification can be found within Sarkissian. Support for the lack of teaching within Sarkissian is set forth in more detail below.

Sarkissian discloses an office attendant type program that may be used to manage or control telephony and other related functions of a communications system (see, e.g., Sarkissian, paragraph 0091). However, Sarkissian fails to provide teaching or suggestion for receiving an electronic notification of a change to a directory entry stored within an electronic communications device, where the electronic notification includes an identifier, category heading and an altered value, as recited in present claim 1.

Instead, Sarkissian suggests that a computer running the office attendant type program may download a current telephone subscriber directory (e.g., a complete listing of the telephone subscribers, extensions, and status information, such as do not disturb, forward and forwarding information, etc.) from communications system 50 (see, Sarkissian, paragraph 0092). If communications system 50 determines that subscriber information has changed, the telephone subscriber directory may be updated in one of two ways. In a first embodiment, "communications system 50 may 'broadcast' updated subscriber directory information to all computers coupled to communications system 50" (Sarkissian, paragraph 0093). In a second embodiment, "communications system 50 sends a net message, email or other message to such computers coupled to communications system 50 that prompts the users of such computers to the availability of the subscriber directory update" (Sarkissian, paragraph 0093). As such, Sarkissian provides teaching for receiving "updated subscriber directory information" (presumably, an "altered value"), or alternatively, for receiving a message (presumably, an "electronic notification") that simply indicates the "availability of a subscriber directory update."

Sarkissian, however, fails to disclose that the update message or the update information may include an identifier, a category heading and an altered value, as recited in present claim 1. One simply cannot presume that the alleged "electronic notification" of Sarkissian (i.e., the message indicating availability of an update) necessarily includes an identifier, a category heading and an altered value, without sufficient motivation to do so.

For at least these reasons, Shaffer and Sarkissian each fail to provide teaching or suggestion for the above-mentioned limitation of present claim 1. Therefore, even if the "electronic notification" of Sarkissian were incorporated into the teachings of Shaffer, as suggested by the Examiner, the combined teachings of the cited art would still fail to disclose all limitations of present claim 1.

In addition, the cited art cannot be modified to disclose the aforementioned claim limitation, since neither Shaffer nor Sarkissian suggest a desirability for doing so. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination [or modification]. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01. There is simply no motivation within the cited art to modify the teachings of Shaffer and/or Sarkissian to include the aforementioned claim limitation.

Since none of the cited art teaches, suggests, or provides motivation for the aforementioned claim limitation, the cited art cannot be combined or modified to do so. As stated above, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP 2143.01.

Shaffer and Sarkissian also fail, both separately and in combination, to provide teaching or suggestion for automatically updating the directory entry to include the altered value, where the step of automatically updating includes: (i) comparing the identifier of the electronic notification to entry identifiers corresponding to a plurality of directory entries stored within the electronic communications device, (ii) comparing the category heading of the electronic notification to field headings corresponding to the plurality of directory entries, upon matching the identifier of the electronic notification to an entry identifier associated with the directory entry, and (iii) replacing one or more entry content values corresponding to the directory entry with the altered value, upon

matching the category heading of the electronic notification to one or more field headings associated with the directory entry. Amended claim 1 recites, in part:

An electronic communications device comprising: a processor; and a storage medium comprising program instructions executable by the processor for... automatically updating the directory entry to include the altered value upon receipt of an acceptance command generated by the user, wherein the step of automatically updating the directory entry comprises: comparing the identifier of the electronic notification to entry identifiers corresponding to a plurality of directory entries stored within the electronic communications device; comparing the category heading of the electronic notification to field headings corresponding to the plurality of directory entries, upon matching the identifier of the electronic notification to an entry identifier associated with the directory entry; and replacing one or more entry content values corresponding to the directory entry with the altered value, upon matching the category heading of the electronic notification to one or more field headings associated with the directory entry.

Support for the amendments made to claim 1 may be found in cancelled claims 17-19. As such, the amendments made herein do not constitute new matter or warrant a new search. As noted above, Applicant's contend that no teaching or suggestion can be found within Shaffer, Sarkissian or any combination thereof for an electronic notification including an identifier, a category heading and an altered value. However, in an effort to expedite prosecution, the Applicant's further limit claim 1 to a particular manner in which the presently claimed electronic notification may be used to automatically update the director entry.

In the claimed embodiment, for example, the step of automatically updating may include: (i) comparing the identifier of the electronic notification to entry identifiers corresponding to a plurality of directory entries stored within the electronic communications device, (ii) comparing the category heading of the electronic notification to field headings corresponding to the plurality of directory entries, upon matching the identifier of the electronic notification to an entry identifier associated with the directory entry, and (iii) replacing one or more entry content values corresponding to the directory entry with the altered value, upon matching the category heading of the electronic notification to one or more field headings associated with the directory entry. These steps (or program instructions executed for performing these steps) are not taught or suggested by Shaffer or Sarkissian, as described in more detail below.

First of all, Shaffer and Sarkissian each fail to provide teaching or suggestion for receiving an electronic notification including an identifier, a category heading and an altered value. Statements in the Office Action admit that teaching for such electronic notification cannot be found within Shaffer (Office Action, page 3), and arguments are provided above for the lack of teaching within Sarkissian. As such,

Shaffer and Sarkissian cannot teach or suggest, nor can they be combined or modified to teach or suggest, that a directory entry may be automatically updated with a process (or program instructions configured for performing a process), which specifically uses the identifier and category heading from the electronic notification to perform the update.

Second, even if one skilled in the art were to improperly assume that the "electronic notification" of Sarkissian (e.g., the message indicating availability of an update) necessarily included an identifier, a category heading and an altered value, it would be unreasonable for one skilled in the art to further assume that a directory entry could be automatically updated in the specific manner claimed. In other words, Sarkissian provides absolutely no teaching, suggestion, motivation or even desirability for automatically updating a directory entry to include an altered value, where the step of automatically updating includes: (i) comparing the identifier of the electronic notification to entry identifiers corresponding to a plurality of directory entries stored within the electronic communications device, (ii) comparing the category heading of the electronic notification to field headings corresponding to the plurality of directory entries, upon matching the identifier of the electronic notification to an entry identifier associated with the directory entry, and (iii) replacing one or more entry content values corresponding to the directory entry with the altered value, upon matching the category heading of the electronic notification to one or more field headings associated with the directory entry.

For at least the reasons set forth above, none of the cited art teaches, suggests, or provides motivation for all limitations of independent claim 1. In addition, the cited art cannot be combined or modified to do so. Therefore, independent claim 1 and all claims dependent therefrom, are considered to be patentably distinct over the cited art. Removal of this rejection is hereby respectfully requested.

Shaffer fails to provide teaching or suggestion for a storage medium (claim 22) or method (claim 21) for updating a directory entry, where the update method includes searching an entirety of directory entries to match an identifier of an electronic notification with a matching entry identifier associated with the directory entry, and matching a category heading of the electronic notification to a field heading associated with the directory entry. Originally filed claim 21 recites, in part:

A method ... comprising ... searching entirety of directory entries to match an identifier of the electronic notification with a matching entry identifier associated with the directory entry; matching a field heading associated with the data structure of the directory entry with a category heading of said electronic notification; and updating one or more entry

content values with the altered value, wherein said entry content values correspond to a field associated with the matching entry identifier and field heading of the directory entry.

As noted above, Shaffer simply fails to provide teaching, suggestion, or motivation for an electronic notification message including an identifier and category heading. The Examiner appears to agree that such teaching cannot be found within Shaffer (*see*, Office Action, page 3). For at least this reason, Shaffer cannot be relied upon to provide teaching or suggestion for the presently claimed method (claim 21) and storage medium (claim 22), which uses the identifier and category heading from the electronic notification to perform the update process.

Statements in the Office Action admit that "Shaffer does not clearly shows [sic] the method... steps of updating the directory including searching and matching of directory before update." (Office Action, page 7). However, the Examiner appears to suggest that the presently claimed steps of searching and matching would be necessarily included within the teachings of Shaffer "in order to update or replace the telephone number in the telephone directory." (Office Action, page 7). For at least the reasons set forth below, the Applicants respectfully disagree with the Examiner's assertion that: (1) the teachings of Shaffer could be modified to include the presently claimed steps of searching and matching, and (2) it would have been obvious to one skilled in the art to do so.

In column 3, lines 10-37, Shaffer discloses the use of an electronic "new number message," which may be broadcast to a destination telephone for updating a directory entry stored within the telephone. To update the directory entry, Shaffer discloses that the destination telephone may include "a processing unit that is programmed to recognize the message as a new number message and to read from the message the old telephone number and the new telephone number. After reading the new number message, the destination telephone updates ... [a] record in the database 76 with the new telephone number." (Shaffer, column 3, lines 14-20). Since the "new number message" of Shaffer includes both the old telephone number and the new telephone number, Shaffer appears to suggest that the new telephone number simply replaces the old. By including the old telephone number within the "new number message", Shaffer fails to teach, suggest or demonstrate a need for searching an entirety of directory entries to match an identifier of an electronic notification with a matching entry identifier associated with the directory entry, and matching a category heading of the electronic notification to a field heading associated with the directory entry, as recited in present claims 21 and 22.

Furthermore, it would not be obvious to one skilled in the art that such steps would be necessarily performed, or that Shaffer could somehow be modified to perform the presently claimed steps of searching and matching. For example, Shaffer fails to teach, suggest or provide motivation for receiving an electronic notification including an identifier, a category heading and an altered value. Shaffer also fails to suggest that the telephone directory entries may be organized into groups or categories. As such, Shaffer provides absolutely no motivation that would enable one skilled in the art to reasonably conclude that the update method of Shaffer could be modified to include the presently claimed steps of searching an entirety of directory entries to match an identifier of an electronic notification with a matching entry identifier associated with the directory entry, and matching a category heading of the electronic notification to a field heading associated with the directory entry.

Further statements in the Office Action suggest that, in order to update or replace a telephone number in the telephone directory, the following steps are inherently taught by Shaffer. For example, the Examiner suggests that, in order to update a telephone number, the method of Shaffer must necessarily: (i) read the old number in the directory associated with the new number, (ii) determine if the new number matches the old number, and (iii) update the directory with the new number (*see*, Office Action, page 7). Applicants assert that even if such steps are inherently taught by Shaffer, they do not read upon the limitations actually recited in claims 21 and 22.

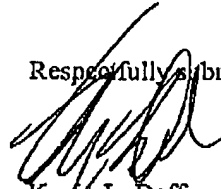
For at least the reasons set forth above, Shaffer fails to teach, suggest or provide motivation for all limitations of independent claims 21 and 22. Therefore, independent claims 21 and 22 are considered to be patentably distinct over the cited art. Removal of this rejection is hereby respectfully requested.

CONCLUSION

This response constitutes a complete response to the issues raised in the Office Action mailed January 14, 2005. In addition, the prior art made of record but not relied upon is not considered pertinent to the presently claimed case. In view of the remarks traversing the rejections, Applicants assert that pending claims 1, 3-8, 10-16, 21 and 22 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Daffer McDaniel LLP Deposit Account No. 50-3268/5468-05000.

Respectfully submitted,



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